REMARKS

Claim Amendments

Claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 are pending and under current examination. By this Amendment, Applicants have amended claims 1, 13, 25, and 37 solely to improve clarity. No new matter was introduced.

Office Action

The Office Action (1) rejected claims 1, 4-13, 16-25, 28-37, and 40-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,422,821 ("Allen") in view of a webpage for "NCOA Description" from www.anchorcomputer.com (Reference U of the PTO-892) ("Anchor"); and (2) rejected claims 57-64 under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of U.S. Patent Application Pub. No. 2002/0029202 A1 ("Lopez") and Anchor.

Regarding Office Action's Response to Arguments

In the "Response to Arguments" section, the Office Action alleges that "Applicant's specification merely describes a type of incorrect address and contrary to Applicant's arguments, fails to define an explicit definition for an incorrect address." Office Action, p. 3. Applicants disagree with the Office Action's allegations.

As disclosed in Applicant's specification, "[a]n incorrect address record may comprise an un-coded address that includes a delivery address that does not match information in the ZIP+4 database due, for example, to bad delivery address information." Specification, ¶ [049]. "An incorrect address record may also comprise, for example, an address without a ZIP+4 (or 9 digit) code." Id. The specification also discloses correcting the incorrect address using at least one of a plurality of address

resolution processes. *See e.g.*, specification, ¶¶ [050]-[051]. Therefore, whether or not the specification include "an explicit definition for an incorrect address," as alleged by the Office Action at page 3, is irrelevant, at least because the "incorrect address" recited in the claims is supported by the specification at, *e.g.*, ¶¶ [048]-[051] and [056].

Nevertheless, without conceding with the Office Action's allegations, Applicants have amended claim 1 to recite, in part, "an incorrect address that contains a delivery format error." Applicants submit that this amended definition of "an incorrect address" is also supported by the specification at, *e.g.*, ¶¶ [048]-[051] and [056].

The Office Action alleges that "Allen does teach an incorrect address consistent with the plain meaning of the term and Applicant's specification." Office Action, p. 3. However, the Office Action, should not interpret the "incorrect address," as recited in claim 1, with the alleged "plain meaning" that includes Allen's former address. This is because amended claim 1 specifically defines an incorrect address to be one that "contains a delivery format error." In contrast, Allen's former, no longer valid address that is stored in the NCOA database does not fall within the meaning of the "incorrect address" defined in claim 1, because Allen's former address stored in the NCOA database matches a predetermined deliverable address format set forth in the NCOA database. *See* Allen, col. 1, line 25; col. 4, lines 49-52; and col. 6, line 65 to col. 7, line 4. As a result, and as one of ordinary skill in the art would appreciate, Allen's former address stored in the NCOA database does not contain "a delivery format error" as required by claim 1. This is also demonstrated in Anchor's table shown in ¶ 8, which shows that addresses stored in the NCOA database match a predetermined delivery format, and do not contain a delivery format error.

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Therefore, for at least the above reasons, Allen's former address stored in the NCOA database does not constitute "an incorrect address that contains a delivery format error," as recited in amended claim 1.

Regarding Rejections of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established with respect to these claims.

To establish a *prima facie* case of obviousness, the Office Action must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. *See* M.P.E.P. § 2144.08(II)(A). Furthermore, the Office Action must make findings with respect to all of the claim limitations and must make "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See Id.* §§ 2143.03 and 2141(III).

Claim 1 recites, among other things, the following elements:

> receiving a first instance of an incorrect address that contains a delivery format error, the incorrect address being associated with a first item . . .

> storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error; [and] . . .

> comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address.

As discussed above, Allen does not teach or suggest an "incorrect address," as recited in amended claim 1, because Allen's former, no longer valid address that is

stored in the USPS National Change of Address (NCOA) database does not contain "a

delivery format error." As a result, contrary to the Office Action's allegation on p. 3,

Allen does not teach or suggest, among other things, "storing a resolved address in a

database, the resolved address comprising the correct address and the first instance of

the incorrect address that contains the delivery format error," as recited in amended

claim 1 (emphases added).

In addition, Allen does not teach or suggest "comparing the second instance of

the incorrect address to the stored resolved address to determine that the second

instance of the incorrect address matches the stored first instance of the incorrect

address," wherein the incorrect address "contains the delivery format error," as recited

in amended claim 1 (emphases added). As pointed out in Applicant's Amendment filed

September 14, 2009, Allen merely discloses comparing an address from a mailpiece

with a former address stored in the NCOA database, wherein the former address is not

an "incorrect address" within the definition of amended claim 1, because the former

address does not contain a delivery format error. *See e.g.*, Allen, col. 2, lines 57-67.

The Office Action relies on Anchor to allegedly cure the deficiencies of Allen.

Anchor discloses "process[ing] your [list of addresses] and mak[ing] all necessary

address corrections . . . [and] standardiz[ing] your addresses and add[ing] ZIP+4 Codes

to your address file." Anchor, ¶ 7. The table shown in ¶ 8 of Anchor illustrates a

comparison of addresses from a mail file with addresses stored in the NCOA database

in order to obtain new addresses for forwarding mailpieces. The Office Action alleges

that Anchor teaches an "incorrect address that contains an error - (the street name, city

and state) [in the table shown in ¶ 8] that is correctable to match the predetermined new

address format." Office Action, p. 3. However, as discussed above, the former, no longer valid address that is stored in the NCOA database in Anchor does not constitute or suggest an address having the claimed "delivery format error." Accordingly, Anchor does not disclose or suggest, among other things, "<u>storing</u> a resolved address in a database, the resolved address comprising the correct address and the first instance of <u>the incorrect address that contains the delivery format error</u>," as recited in amended claim 1 (emphases added).

Moreover, even if Anchor is combined with Allen, as proposed by the Office Action, the combination still would not teach or suggest, among other things, "<u>comparing</u> the second instance of the incorrect address to the stored resolved address <u>to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address</u>," wherein the incorrect address "contains the delivery format error," as recited in amended claim 1 (emphases added).

The Office Action further relies on Lopez to allegedly cure the deficiencies of Allen and Anchor. However, like Allen and Anchor, Lopez also does not teach or suggest, among other things, "<u>storing</u> a resolved address in a database, the resolved address comprising the correct address and the first instance of <u>the incorrect address that contains the delivery format error</u>," as recited in amended claim 1 (emphases added). Furthermore, like Allen and Anchor, Lopez also does not teach or suggest "comparing the second instance of the incorrect address to the stored resolved address to <u>determine that the second instance of the incorrect address matches the stored first instance of the incorrect address</u>," as recited in amended claim 1 (emphasis added).

The Office Action does not allege otherwise. Indeed, Lopez does not teach or suggest these elements. Therefore, Lopez does not cure the deficiencies of Allen and Anchor.

For at least the foregoing reasons, Allen, Lopez, and Anchor, whether taken alone or in combination, fail to teach or suggest the elements recited in amended claim 1, and the Office Action has incorrectly determined the scope and content of the prior art. Moreover, the undisclosed elements represent significant differences between the claimed invention as a whole and the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and it is allowable over the cited references. Dependent claims 4-12 and 57-59 are also allowable, at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Although of different scope, independent claims 13, 25, and 37, as amended, include elements similar to those discussed above in connection with amended claim 1. For at least the same reasons discussed above with respect to claim 1, independent claims 13, 25, and 37 are allowable over the cited references. Dependent claims 16-25, 28-37, 40-48, and 60-64 are also allowable, at least by virtue of their dependence from independent claims 13, 25, or 37, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

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The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 25, 2010   By:_____
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